

REMARKS

Claims 1-7, 9-19, and 31-32 are pending in the application. Claims 8 and 20-30 have been previously cancelled and claims 31-32 have been previously added. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. §§ 102 AND 103

Claims 1-7 and 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grant-Acquah (U.S. Pat. No. 6237919). Reconsideration of this rejection is respectfully requested.

At the outset, Applicant notes that claim 1 includes the limitation of "a light colored pigment intermixed with the encapsulant to thereby create a light colored encapsulant that has a brightness above 75 on a CIE L*A*B color and brightness rating system."

The Examiner asserts that Grant-Acquah '919 discloses "a light colored pigment (i.e., up to 10 parts by weight) intermixed with the encapsulant to thereby create a light color encapsulant." However, Applicant respectfully submits that this assertion is incorrect. In particular, while Applicant acknowledges that Grant-Acquah '919 discloses that "[p]igment may also be added to the mixture at up to about 10 parts by weight" (col. 4, lines 10-11), there is no teaching or suggestion that the pigment is "light colored" as improperly asserted by the Examiner. Applicant submits that there is no evidence in Grant-Acquah '919 that a "light colored" pigment is anticipated, taught, or suggested by

that reference. It is only through impermissible hindsight that the Examiner has inferred that Grant-Acquah '919 discloses a light colored pigment.

The present application discloses the use of a light colored encapsulant on an engine cylinder-head gasket in order to facilitate gasket leak path analysis and to detect debris on the gasket prior to installation (see paragraph [0028]). There is no teaching or suggestion in Grant-Acquah '919 of this benefit. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) cert. denied, 389 U.S. 1057 (1968). The mere fact that the prior art could be so modified, would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, the prior art fails to teach or suggest the desirability of the claimed invention. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 and § 103.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is

believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (734) 354-5445.

Respectfully submitted,

Dated: SEP. 16, 2005

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